

Remarks

This Application has been carefully reviewed in light of the Office Action mailed August 1, 2003. Applicants appreciate the Examiner's consideration of Applicants' previous Response and the withdrawal of the previous rejections under 35 U.S.C. § 103(a). Since Applicants believe all pending claims are allowable over the prior art without amendment, no amendments have been made. Applicants provide the following additional remarks. Applicants respectfully request reconsideration and allowance of all pending claims.

The Claims are Allowable over *Henson* in view of *Rhythm*

The Examiner rejects Claims 1-4 and 6-43 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,167,383 to Henson ("*Henson*") in view of a series of pages from i2 Technologies' website dated 5/26/98 ("*Rhythm*"). Applicants respectfully disagree.

Applicants' claims recite, *during a product configuration session, for each of a series of selection option sets, dynamically applying an optimization function with respect to each item in the selection option set, according to data received from an available-to-promise engine during the product configuration session to identify an item of the selection option set as a default selection, the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function.* Applicants appreciate the Examiner's acknowledgement that the primary reference *Henson* does not disclose the "dynamically applied optimization features" recited in Applicants' claims. (Office Action, Page 2) The secondary reference *Rhythm* merely mentions optimization in the context of supply chain management activities such as planning and scheduling. Notably, the only portion of *Rhythm* even marginally related to configuring a product, entitled "Order Promising," is devoid of any mention of optimization.

Even if it would have been possible at the time of Applicants' invention to combine *Rhythm* with *Henson*, which Applicants dispute, and even if there was the required suggestion or motivation to do so, which Applicants also dispute, the proposed *Henson-Rhythm* combination still would provide no disclosure, teaching, or suggestion of, as recited in Applicants' independent Claim 1 (and similarly in Applicants' other independent claims):

- *during a product configuration session*

- *for each of a series of selection option sets*
- *dynamically applying an optimization function with respect to each item in the selection option set*
- *according to data received from an available-to-promise engine during the product configuration session*
- *to identify an item of the selection option set as a default selection*
- *the default selection being optimal among the one or more items of the selection option set with respect to the dynamically applied optimization function*

Examples of the dynamic nature of the optimization function recited in Applicants' independent Claim 1 are provided in dependent Claims 7-9, which recite as particular examples defining the optimization function "during the configuration session" (Claim 7), "in response to an identification of the user during the configuration session" (Claim 8), and "in response to a product selection decision made by the user during the configuration session" (Claim 9).

Furthermore, with respect to the Examiner's proposed combination of *Rhythm* with *Henson*, Applicants respectfully submit that the Examiner has not shown anything in *Henson*, *Rhythm*, or in knowledge generally available to those of ordinary skill in the art at the time of the invention that would have suggested or motivated one of ordinary skill in the art at the time of the invention to combine these references in the manner the Examiner proposes. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis in original). Thus, the mere fact that the teachings of one reference might possibly improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine the references. Nothing in *Henson*, *Rhythm*, or knowledge generally available to those of ordinary skill in the art at the time of the invention would have suggested or motivated the proposed combination, nor has the Examiner provided any specific evidence that suggests or motivates the proposed combination.¹

¹ If "common knowledge" or "well known" art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If

The Examiner merely asserts in conclusory fashion that it "would be obvious" to include in *Henson* optimization capabilities as disclosed in *Rhythm* "because this would increase the likelihood of promised delivery dates being met and increase customer satisfaction" (Office Action, Page 3) – that is, the combination would have been obvious because it would benefit the company employing the invention. Applicants note again that *Henson* was filed on behalf of a well known manufacturing company renowned for its efficiency and innovation and describes the features and operation of the company's actual or proposed "online store user interface for enabling custom configuration, pricing, and ordering of a computer system via the Internet." (Column 1, Lines 18-21) Yet *Henson* does not disclose, teach, or suggest in any way the very features and operation the Examiner concludes would be beneficial to the company and therefore obvious. Similarly, virtually every other manufacturing company with an online sales presence would have incorporated Applicants' invention, or something substantially similar to it, into its online store to achieve the resulting benefits were it obvious to do so. Yet the Examiner has not supplied any other prior art references disclosing, teaching, or suggesting the dynamically applied optimization features of Applicants' invention. In any event, Applicants respectfully point out that speculation in hindsight that it "would have been obvious" to make the proposed combination because the proposed combination would provide certain benefits is insufficient under the M.P.E.P.² and governing Federal Circuit case law.³ Indeed, if such was the proper standard for finding obviousness, the patent system would likely cease to exist in any meaningful form.

personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03. Furthermore, the Examiner does not particularly point out the information of which the Examiner takes Official Notice. If Official Notice is being taken, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03.

² See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

³ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1, 10, 20, 28, and 36 and all claims that depend on these claims.

Applicants' independent Claim 10 further recites "*for each selection option set, before presenting the selection option set to the user, determining which of the items of the selection option set are actually available to the user in accordance with a user-specified date constraint and presenting only those items of the selection option set which are actually available to the user in accordance with the user-specified date constraint.*" Similar limitations are recited in Applicants' independent Claim 20 and dependent Claims 2, 31, and 39. As discussed in Applicants' previous Response but not addressed by the Examiner in the Office Action, *Henson* discloses providing to the user a warning indicator to indicate an option which, if already selected or selected in the future by the user, would represent an invalid configuration or would adversely impact a shipment or delivery date of the configured product. Using the system disclosed in *Henson*, as clearly illustrated in Figure 4, the user is presented with all options and remains free to at least initially select any of these options. Numerous examples from *Henson* demonstrating this distinction were provided in a previous Response. Applicants respectfully reiterate their remarks in their previous Response concerning the obviousness rejections of independent Claims 10 and 20 and dependent Claims 2, 31, and 39.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 10 and 20, all claims that depend on these claims, and dependent Claims 2, 31, and 39.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

Conclusion

Applicants have made an earnest attempt to place this Application in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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